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REMARKS

In this Response, Applicant cancels claims 15, 16, 19-32, 44, 54, and 55, amends claims 1, 2, 5, 6, 8-10, 14, 17, 18, 33-36, 38, 39, 45-48, 50, 53, 56, and 57, and removes the bases for the Examiner's rejections. Applicant amends the claims solely to expedite prosecution and does not acquiesce to any of the Examiner's rejections. Applicant's amendments to the claims are supported throughout the application. Applicant's silence with regard to the Examiner's rejections of dependent claims constitutes a recognition by the Applicant that the rejections are moot based on the Amendment and/or Remarks relative to the independent claim from which the dependent claims depend. Applicant reserves the option to further prosecute the same or similar claims in the present or a subsequent application. Upon entry of the Amendment, claims 1-14, 17, 18, 33-43, 45-53, 56, and 57 are pending in the present application.

Claim Rejections

The Examiner rejected claims 1, 3-9, 11-21, 23-30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Saxe in view of Heinly.

The Examiner also rejected claims 2, 10, 22, 31, 36, 48, and 53-58 under 35 U.S.C. § 103(a) as being unpatentable over Saxe in view of Heinly and Wright.

The Examiner also rejected claims 33-35, 37-47, and 49-52 under 35 U.S.C. § 102(b) as being anticipated by Saxe.

Claims 1-8

Applicant's independent claim 1 describes a method by which a targeted list of prospective customers can be generated for a first list purchaser based on prospect lists that are included in a database. Each prospect list in the database is associated with (i) a list purchaser who used the prospect list and (ii) for each list purchaser who used the prospect list, data that indicates whether the list was successful based on feedback from the list

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purchaser. Different types of lists are identified in the database to generate the targeted list. Specifically, as claimed in claim 1, successful lists for the first list purchaser are identified in the database. Based on the lists in the database, one or more other list purchasers who used one or more of the successful lists for the first list purchaser are determined. Successful lists used by the one or more other list purchasers are then identified. The targeted list includes one or more of the successful lists for the first list purchaser and one or more of the successful lists for the one or more other list purchasers who used one or more of the successful lists for the first list purchaser.

Saxe describes a method for targeting advertisements to a selected type of cable subscriber. As described in Saxe col. 4, ll. 18-26 and col. 5, ll. 42-46, Saxe generates a database of cable subscribers, in which each such subscriber is associated with demographic information. As further described in Saxe col. 7, ll. 1-29, Saxe generates a profile of a type of cable subscriber that a company desires to reach with an advertisement. Saxe generates this profile based on the company's list of its customers (Saxe col. 11, ll. 16-19) and/or a related company's list of its customers (Saxe col. 10, ll. 34-47). Saxe then identifies those cable subscribers in the database having demographic data consistent with the profile. (Saxe col. 6, ll. 28-33 and col. 7, ll. 17-19). Subsequently, Saxe broadcasts the advertisement to the so identified cable subscribers in the database.

In contrast to Applicant's independent claim 1, Saxe does not provide a database of prospect lists, i.e., a database that includes lists of prospective customers, in which each such list is associated with data that indicates whether the list was successful based on feedback from a list purchaser. As previously described, Saxe generates a database that includes cable subscribers. Saxe's cable subscribers are not Applicant's claimed prospective customers as Saxe's cable subscribers are subscribers to a cable system, and have not been determined to be prospective customers for a list purchaser. Moreover, Saxe's cable subscribers are not organized in the form of Applicant's claimed lists. Regardless, even if Saxe's cable subscribers are organized in the form of lists, Saxe does not associate those lists with data that indicates whether the list was successful for a list purchaser based on feedback from the list purchaser, as claimed in Applicant's independent claim 1. Saxe does

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not, therefore, teach or suggest the feature of independent claim 1 directed to *providing a database of prospect lists*. Since Saxe does not provide a database of prospect lists, Saxe cannot teach or suggest the features of independent claim 1 directed to *identifying in the database one or more other list purchasers, identifying in the database successful lists for the other list purchasers, and providing access to a targeted list that includes one or more of those successful lists*.

As previously described, Applicant's independent claim 1 includes identifying successful lists for the first list purchaser and, based on the lists in the database, identifying one or more other list purchasers who used one or more of the successful lists for the first list purchaser. In further contrast to independent claim 1, and regardless of whether Saxe provides a database of prospect lists, Saxe does not identify the Applicant's claimed one or more other list purchasers. At most, Saxe generates a profile for a first company who desires to target an advertisement to a certain type of cable subscriber based on the first company's list of its customers and/or a second related company's list of its customers. Saxe does not, however, identify a company who has used one of the successful lists for the first company, e.g., the first company's list of its customers. Since Saxe does not identify such a company, Saxe does not teach or suggest the feature of Applicant's independent claim 1 directed to *identifying one or more other list purchasers who used one or more of the successful lists for the first list purchaser*. Since Saxe does not identify the one or more other list purchasers, Saxe cannot teach or suggest the features of claim 1 directed to *identifying successful prospect lists for the one or more other list purchasers and providing access to a targeted list that includes one or more of those successful lists*.

With regard to Heinly, Heinly also does not identify the claimed one or more other list purchasers. Heinly describes a method for increasing sales of real estate in a slow economy. In pertinent part, Heinly advocates "[m]aintaining a prospect list of former customers and of nonbuying traffic." (Heinly, p. 2 [internal quotation marks omitted].) At most, Heinly stores one company's list of its former customers and that one company's list of non-buying traffic. Heinly does not, however, identify a different company who has used one of the successful lists of that one company, e.g., that one company's list of former

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customers. Since Heinly does not identify such a company, Heinly does not teach or suggest the feature of Applicant's independent claim 1 directed to *identifying one or more other list purchasers who used one or more of the successful lists for the first list purchaser*. Since Heinly does not identify the one or more other list purchasers, Heinly cannot teach or suggest the features of claim 1 directed to *identifying successful prospect lists for the one or more other list purchasers and providing access to a targeted list including one or more of those successful lists*.

In summary, neither Saxe nor Heinly teaches or suggests at least the features of Applicant's independent claim 1 directed to *identifying one or more other list purchasers who used one or more of the successful lists for the first list purchaser, identifying successful prospect lists for the one or more other list purchasers, and providing access to a targeted list including one or more of those successful lists*.

As the Examiner knows, the Examiner must show that all the features of Applicant's independent claim 1 are satisfied by the cited references to establish a prima facie case of obviousness under 35 U.S.C. § 103(a). As provided herein, neither Saxe nor Heinly, whether considered separately or in combination, teaches all of the features of Applicant's independent claim 1. The Examiner thus fails to provide prima facie cases of obviousness for at least this reason. Applicant's failure to address the motivation and reasonable expectation of success elements of 35 U.S.C. § 103(a) should not be interpreted as an admission that such elements are satisfied, but rather as a recognition by the Applicant that such elements are moot given the Examiner's failure to provide a showing of all the features of Applicant's independent claim 1.

Accordingly, Applicant traverses the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 1 and considers independent claim 1 to be allowable. Since claims 2-8 depend from allowable independent claim 1, claims 2-8 are allowable based on their dependency from an allowable base claim.

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Claims 9-14, 17, 18, 33-43, 45-53, 56, and 57

Independent claims 9, 14, 33, 45, and 53 are directed to methods, computer-readable storage media, and systems and include features similar to those in allowable independent claim 1. For the same reasons as provided herein relative to Applicant's independent claim 1, Applicant similarly traverses the Examiner's rejections of independent claims 9, 14, 33, 45, and 53. Furthermore, since independent claim 1 is allowable, independent claims 9, 14, 33, 45, and 53 and claims 10-13, 17, 18, 32-43, 46-52, 56, and 57 depending therefrom, are also allowable.

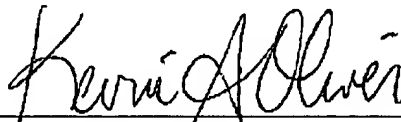
Based on the foregoing Amendment and Remarks, Applicant traverses the Examiner's rejections of claims 33-25, 37-47, and 49-52 under 35 U.S.C. § 102(b) and claims 1-32, 36, 48, and 53-58 under 35 U.S.C. § 103(a).

CONCLUSION

Applicant considers the Response herein to be fully responsive to the cited Office Action. Based on the foregoing Amendment and Remarks, this application is in condition for allowance. Accordingly, Applicant requests allowance.

Applicant invites the Examiner to contact Applicant's Attorney if any issues are deemed to remain prior to allowance.

Respectfully submitted,



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